



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,405	01/22/2004	Kenji Miyata	A8319.0030/P030	3308
24998	7590	11/21/2005	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP			ASSOUAD, PATRICK J	
2101 L Street, NW			ART UNIT	PAPER NUMBER
Washington, DC 20037			2857	

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/761,405

Applicant(s)

MIYATA, KENJI

Examiner

Patrick J. Assouad

Art Unit

2857

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is responsive to the Amendment filed 11/7/05. Claims 1-20 are pending.

Response to Arguments

2. Applicant's arguments filed 11/7/05 with respect to the 35 USC 101 rejection have been fully considered but they are not persuasive. Applicant cites several cases including Ex parte Lundgren, Appeal No. 2003-2088 (2005).
3. The PTO has issued "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility." See the USPTO Website, or http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf.
4. The Guidelines specifically require either a "physical transformation" or "concrete and tangible result" when the instant claimed invention is directed to an abstract idea or solely involves mathematical calculations.
5. Claims 1-6 and 9-15 are directed to a *method* of magnetic field analysis. Claims 7 and 16-20 are directed to a *computer program*. Claim 8 is directed to a *computer program stored on a computer readable storage medium*.

Art Unit: 2857

6. As per claims 7 and 16-20, computer programs, per se, do not fall under any of the statutory classes of invention, namely: process, machine, manufacture, or composition of matter. When a computer program is not stored on an appropriate computer readable medium to enable any underlying functionality to be realized, the computer program is not statutory under 35 USC 101.

7. With respect to all other pending claims in the instant case, there is no claimed "physical transformation" of any kind in any of the claims. Similarly, there is no "concrete, tangible result" seen in the claims; we merely see "receiving...[data, and] calculating [data]." Except for *possibly* dependent claim 19 which refers to "displaying," there is no clear evidence that a concrete, tangible result is utilized in any manner whatsoever.

8. As per claim 8, we must turn to the instant Specification for interpreting the "computer readable storage medium"-limitation:

When the program is to be supplied to such a computer system, the program is stored in a storage medium such as a magnetic disk 61 such as shown in Fig. 6 and a CD-ROM 71 such as shown in Fig. 7. The storage medium distributed and kept is installed in the computer 52 to read the program with a magnetic disk drive or a CD-ROM drive of the computer 52. If the program distributed via a communication network is input to the input means, the program is stored in the storage medium such as a magnetic disk to allow repetitive use of the program.

9. In light of the above, claim 8 may fall under the "article of manufacture" class in that the storage medium may be a magnetic disk or CD-ROM; however, it has the same deficiencies as indicated above for the method claims in that there is no concrete, tangible result.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

12. Applicant is again urged to see the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" currently at

[http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.p](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf)

[df](#). See the above analysis.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

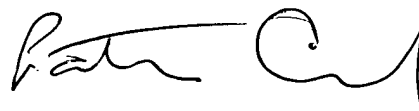
Art Unit: 2857

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick J. Assouad whose telephone number is 571-272-2210. The examiner can normally be reached on Tuesday-Friday, 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc Hoff can be reached on 571-272-2216. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick J Assouad
Primary Examiner
Art Unit 2857

pja